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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,136	03/27/2001	Darrell C. Conklin	00-25	3811

7590

07/14/2004

Gary E. Parker
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1201 Eastlake Avenue East
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EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/14/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,136

Applicant(s)

CONKLIN ET AL.

Examiner

Delia M. Ramirez

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,23,24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7,23,24 and 26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: <u>Alignment</u> |

DETAILED ACTION

Status of the Application

Claims 1-7, 23-24 and 26 are pending.

Ex parte prosecution of the instant application is re-opened as references relevant to the examination of the instant application are now available. An action on the merits follows.

Priority

1. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 119(e) to provisional application No. 60/193,642 filed on 03/31/2000.
2. It is noted that SEQ ID NO: 2 was first disclosed in provisional application No. 60/193,642 filed on 03/31/2000.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 23-24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Agarwal et al. (U.S. Publication No. 20030139572; corresponding 371 U.S. application is 10/239663) and Agarwal et al. (WO 01/72961 A2, PCT/US01/09226). Since the specification of both documents is the same, specific references will be made with respect to U.S. Publication No. 20030139572. Agarwal et al. discloses a polypeptide (548 amino acids long) which is 100% sequence identical to the polypeptide of

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SEQ ID NO: 2 (Sequence Listing, SEQ ID NO: 47). See attached alignment. Agarwal et al. also discloses a method to recombinantly produce the protein by culturing a host cell comprising an expression vector wherein the vector comprises a polynucleotide encoding the polypeptide as well as the use of signal peptides to secrete the protein to the medium (paragraphs 44, 49-52). Claims 1-7, 23-24 and 26 are directed in part to (1) a polypeptide comprising SEQ ID NO: 2 and fragments of the polypeptide of SEQ ID NO: 2, and (2) the polynucleotide of (1) produced recombinantly by culturing a host cell transformed with an expression vector, wherein the polypeptide is secreted to the medium due to the presence of a signal peptide. Therefore, the teachings of Agarwal et al. anticipate the claims as written.

4. It has been determined that the polypeptide of SEQ ID NO: 47 in U.S. Publication No. 20030139572 and WO 01/72961 A2 were first disclosed in U.S. provisional Application No. 60/192158 filed on 3/24/2000. Since priority has been claimed to U.S. provisional Application No. 60/192158 filed on 3/24/2000, the 102(e) date for U.S. Publication No. 20030139572 and WO 01/72961 A2 is 3/24/2000.

5. It is noted that only relevant pages of the WIPO document will be forwarded to applicants with this Office Action due to its length.

6. The cited U.S. publication is available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Conclusion

7. No claim is in condition for allowance.

8. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 872-9306. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be

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retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
June 25, 2004

Rebecca E. Prouty
REBECCA E. PROUTY
PRIMARY EXAMINER
2004 JUN 25 16:00